

Lloyd WOLFINBARGER
Appln. No. 08/646,520

REMARKS

Claims 10-18 and 28-49 are pending in the present application. Claims 10-13 have been amended to correct claim dependency. Claims 1-9 and 19-27 have been canceled without prejudice or disclaimer. Claims 1-9 have been rewritten as new claims 47-49. Claims 16-27 have been rewritten as new claims 28-46, as follows: claims 16-19 have been rewritten as new claims 28-31, respectively; claim 24 has been rewritten as new claims 32-41; claims 26, 25 and 27, have been rewritten as new claims 42-44, respectively; and claims 20 and 23 have been rewritten as new claims 45 and 46, respectively. No new matter has been added. Reexamination and reconsideration are respectfully requested.

I. The Examiner is thanked for indicating claims 16, 19, and 24-27 allowable if rewritten in independent form.

Claim 16 has been rewritten in independent form as new claim 28. Claims 17 and 18 have been rewritten as new claims 29 and 30, respectively, directed to recirculation only. Claim 19 has been rewritten in independent form as new claim 31. Claim 24 has been rewritten in independent form as new claims 32-41. Claim 25 has been rewritten as new claim 43. Claim 26 has been rewritten as new claim 42. Claim 27 has been rewritten as new claim 44. Claims 20 and 23 have been rewritten as new claims 45 and 46, respectively. Original claims 19-27 have been canceled without prejudice or disclaimer.

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II. At page 2 of the Office Action, claims 11, 20, 22, and 23, have been objected to as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim.

Claim 11 has been corrected to be properly dependant. Claims 20, 22, and 23, have been canceled without prejudice or disclaimer. Accordingly, the Examiner is respectfully requested to withdraw this objection.

III. At page 2 of the Office Action, claims 1, 3, 5-7, 9, 10, 12, 13, and 21, have been rejected under 35 U.S.C. § 102(e) as being anticipated by Morse et. al. ('626).

It appears that the Examiner intends to reject claim 2, not claim 3. Claims 1, 2, 5-7, 9, and 21 have been canceled without prejudice or disclaimer and rewritten as new claims 48-50, directed to negative pressure only. Claims 10-13 have been amended to be dependent on the new claims. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

IV. At page 3 of the Office Action, claims 1, 3-6, 8, 14-15, and 17-18, have been rejected under 35 U.S.C. sec. 102(e) as being anticipated by Morse et. al. (662).

The Examiner states that '662 disclose a method whereby negative pressure is applied in a vacuum at less than atmospheric pressure to remove bone marrow. In view of the following, this rejection is respectfully traversed.

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Claims 1, 3-6 and 8 have been canceled without prejudice or disclaimer. Claims 1 and 3 have been rewritten in independent form as new claim 47. Original claim 4 has been rewritten as new claim 48. Original claims 5, 6, and 8, have been rewritten as new claim 49. Claims 14-18, and new claims 47-49 all require inducing a "negative pressure mediated flow." No new matter has been added.

It is submitted that '662 does not constitute proper prior art against the claims of the present invention since '662 is not entitled to rely on the filing date of its parent application U.S. Patent No.:5,333,626 (first filed on December 31, 1991), since none of the material relating to negative or vacuum pressure added in the CIP application ('662) finds support under 35 U.S.C. § 112 in the parent application '626. Accordingly, '662 is only entitled to its filing date of January 21, 1994, as to the newly added material. Applicant's effective filing date for the present application is the filing date of the first filed application, August 19, 1994 for U.S. Serial No.:293,206, now abandoned which is the parent application of U.S. Patent No.:5,556,379, of which the present application is a division thereof. Filed herewith, please find a declaration under 37 C.F.R. Rule 1.131(a) establishing Applicant's prior invention. In view of the foregoing and the declaration, it is submitted that Morse et. al. '662 does not constitute proper prior art against the claims of the present application.

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Assuming *arguendo* Morse et. al. '662 proper prior art, '662 does not teach subjecting the bone to a negative pressure-mediated "*flow*" of solvent. Anticipation requires that a single prior art reference teach each and every element of the claimed invention. Present claims 1, 3-6, and 8, have been canceled without prejudice or disclaimer and rewritten as new claims 47-49, directed to a negative pressure mediated flow. Claims 10-18, and 47-49 all require inducing a negative pressure mediated "*flow*" of solvent through the bone. The term "flow" is defined in Stedman's Medical Dictionary, 25th ed. , Williams & Wilkins (1990), at page 597 a copy of which is enclosed herewith, as: "...Movement of a fluid....specifically the volume of fluid...passing a given point per unit of time..." '662 does not teach subjecting a bone graft to a negative pressure mediated "flow" of solvent.

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In view of the above, it is submitted that Morse et. al. '662 is not proper prior art against the present claims. Assuming *arguendo* '662 proper prior art, '662 does not teach each and every element of the claimed invention as required for anticipation under 35 U.S.C. § 102. Accordingly, review, reconsideration and allowance of the present claims are respectfully requested. The Examiner is invited to contact the undersigned at her telephone number on any questions that may arise.

Respectfully submitted,

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